

REMARKS

Claim 1 is amended to delete the word "and" so as to provide improved clarity and better syntax and to track the specification language for instance the language in paragraph [0009].

The Examiner is thanked for the courtesies extended during the discussion held March 28, 2006 relating to the election of species requirement. As discussed, the original species election was in error and is a species excluded by the proviso of claim 1. The examination of the elected species was thus outside the scope of the claims. As suggested by the Examiner, Applicants hereby elect a new species, namely 4-dimethylamino-1-(1-methyl-1H-indol-2-yl)-4-phenylcyclohexanol. In this species, with respect to the compound of formula I, both R¹ and R² are methyl, R³ is phenyl and R⁴ is 1-methyl-1H-indol-2-yl which is to say R⁴ is CHR⁶R⁷ wherein R⁶ is H and R⁷ is heteroaryl. The specification indicates that such a heteroaryl may be indol, see for instance, paragraph 19. Examination of this species is respectfully requested.

The rejection of claims 1 – 11 and 125 – 146 under 35 U.S.C. § 102(b) as anticipated by Swahn et al. is respectfully traversed. The elected species is believed to be novel over Swahn et al. as the reference fails to teach this compound. The rejections of claims 147 – 150 under 35 U.S.C. § 102(b) as anticipated by *Eur. J. Med. Chem.* (1984), 19(3), p. 255-260, is respectfully traversed.

Claims 147 – 149 depend from claim 1 and are believed to be novel over the Kamenka et al. reference. Claim 150 is directed to a broader set of compounds than claim 1, however, a method of treating the diseases recited in claim 150 is not described by the reference. In particular, the reference provides no indication of the affinity of the compounds to the ORL-1 receptor and accordingly a person of skill in the art would have no way of knowing that the compounds might be useful in treating the listed indications. As a result, the

reference fails to teach or suggest each and every limitation of claim 150 and the obviousness rejection cannot be properly maintained. Reconsideration and withdrawal thereof are respectfully requested.

The double-patenting rejection under 35 U.S.C. § 101 over application Serial No. 10/758,241 is respectfully traversed. This rejection appears to be in error because there is no overlap between the claims of this application and the claims of the referenced application. The group R³ in this application is limited to aryl or heteroaryl groups, whereas the group R³ in the referenced application is limited to alkyl or cycloalkyl groups or aryl, cycloalkyl or heteroaryl groups bonded via a C₁₋₄ alkylene group. Accordingly, there are compounds that would fall within the scope of one claim but not the other. As a result, identical subject matter is not defined by the claims and statutory double patenting does not exist. Reconsideration and withdrawal of this rejection are respectfully requested.

CONCLUSION

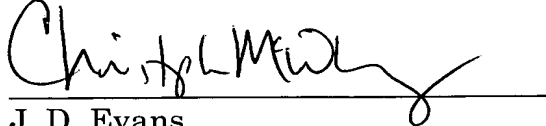
In view of the foregoing, the application is respectfully submitted to be in condition for allowance, and prompt favorable action thereon is earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #029310.53136US).

March 30, 2006

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "J. D. Evans", written over a horizontal line.

J. D. Evans
Registration No. 26,269

Christopher T. McWhinney
Registration No. 42,875

CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
JDE:CTM:mdm (2744544)